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Dominique Conte

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EXAMINER

WIECZOREK, MICHAEL P

ART UNIT

PAPER NUMBER

1712

NOTIFICATION DATE

DELIVERY MODE

04/21/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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DocketingDept@young-thompson.com

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 12, 2010 have been fully considered but they are not persuasive.
2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
4. In response to applicant's argument that Medwick (U.S. Patent No. 2002/0176988) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, though Medwick provides some examples directed toward temporarily protecting large panes of glass, Mediwck does teach that the substrate 12 to be coated may be of any material, including

Art Unit: 1712

glass, and that the glass may be of any type (Page 3 Paragraph 0023). Thus Medwick does not exclusively restrict itself to the highlighted examples of a large glass panes.

5. As the arguments regarding the thickness of the temporary adhesion enhancing coating, though Medwick specifically teaches thickness ranges for the temporary top coating these are only preferred thickness.

Furthermore, Medwick clearly teaches that “the exact thickness of the protective coating...depends on several factors, such as the morphology of the coating, the degree of protection desired, the type of substrate...” (Page 6 Paragraph 0044), thus Medwick clearly teaches that the coating thickness is a cause effective variable since the thickness determines the level of protection for the underlying material. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the temporary adhesion enhancing layer through routine experimentation in the absence of a showing of criticality. *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Applicant argues that the claimed upper limit of 5 nm is critical in that it provides enhanced adhesion to perform trimming with a retaining shoe and at the same time allows the energizing source to act on the outermost surface of the lens. This argument is not persuasive because the aforementioned benefit has not been shown from every coating thickness within the range of less than 5 nm nor has it been shown for every type of material that can be a temporary adhesion enhancing layer having a surface energy higher than that of the outermost layer. Though several examples have been provided within the specification on pages 15 through 17, these examples are only directed toward MF_2 coatings having a thickness of 2 nm.

Art Unit: 1712

6. In response to applicant's argument that one of ordinary skill in the art would not use the material of MacNutt (U.S. Patent # 2,536,075), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As was discussed in the previous Office Action, Medwick teaches that the temporary protective coating may be any high emissivity composition that can be thermally decomposed without adversely impacting the substrate and/or underlying functional coating (Page 8 Paragraph 0059). MacNutt teaches a that magnesium fluoride is a known outermost protective coating for optical glass which has high emissivity for energy and light and can be removed without adversely affecting the underlying substrate. Thus based on the teachings of MacNutt, one of ordinary skill in the art would have a reasonable expectation of success in having the temporary protective coating of Souel in view of Medwick comprises magnesium fluoride. Though the applicant has intended this outer coating to be a temporary adhesion enhancing layer, as was discussed above this layer can perform other functions besides enhancing adhesion and still retain the adhesion enhancing qualities since it is comprised of magnesium fluoride.